APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
2135	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		10/718,290	HOOKER ET AL.
		Examiner	Art Unit
		APRIL Y. SHAN	2135

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _11 December 2007_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-9,11-25 and 27-38_ is/are pending in the application.

   4a) Of the above claim(s) _1-6 and 32-38_ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _7-9, 11-25 and 27-31_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The Applicant's amendment, filed 11 December 2007, has been received, entered into the record, and respectfully and carefully considered.

2.   As a result of the amendment, claims 7, 11 and 23 have been amended. Claims 10 and 26 are canceled. Claims 1-6 and 32-38 have been withdrawn from consideration since they are non-elected claims. Claims 7-9, 11-25 and 27-31 are now presented for examination.

3.   Any objection/rejections not repeated below have been withdrawn due to Applicant's amendment.

Priority

4.   Applicant claimed that the current application claims priority to U.S. Provisional Application No. 60/427,568, entitled "IM Enterprise features," filed Nov. 20, 2002.

Examiner had reviewed carefully the U.S. Provisional Application (60/427,568). The U.S. Provisional application (60/427,568) only broadly discloses secure AIM. However, the examiner discovered at least three claim limitations, the secure message are signed and encrypted **using subscriber's digital certificates**, submitting a certificate publication request, the publication request also specifying a digital certificate corresponding to the subscriber device, responsive to each certificate publication request, the messaging server temporarily storing the submitted digital certificate in a publication record in the independent claim 1 of the current application are **not supported** by the U.S. Provisional application (60/427,568). Therefore, the examiner will not grant the priory date as claimed. The effective filling date of the current application is the filling date of the current application, which is 19 November 2003.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6.   Claims 23-25 and 27-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 23-25 and 27-31 are directed to a messaging server for use in managing the exchange message. However, it appears that the device would reasonably be interpreted by one of ordinary skill in the art as software, per se. There is no element positively recited as part of the server. On par. [1066] of the original disclosure, the Applicant discloses "…such functionality is implemented as….software". It appears that such would reasonably be interpreted as representative of the software. As such, it believed that the device of claims 23-31 is reasonably interpreted as functional descriptive material, per se. Further, storage is being recited in claim 23. The examiner carefully and respectfully reviews page 9 of the original disclosure, the Applicant discloses signal bearing media including analog or digital transmission media and analog…. Computer data signal and carrier wave are not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

9.   This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10.   Claims 7-9, 11-25 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoen et al. (U.S. Pub. No. 20030204720) and in view of Perlman et al. (U.S. Patent No. 5,261,002)

As per **claims 7 and 23**, Schoen et al. discloses a method/messaging server of managing the exchange of secure online instant messages between subscriber devices, where the secure messages are signed and encrypted using subscribers' digital certificates ("PKI encrypted and/or signed IM packets" in fig. 1), the method comprising operations of:

at one or more subscriber devices, an associated local instant messaging module logging in to a messaging server to begin a session of exchanging synchronous

online messages (e.g. IM originator/recipient, **IM Server** in Fig. 1);

at one or more of the logged-in devices, the associated local instant messaging module submitting a certificate publication request to a messaging server, the publication request also specifying a digital certificate corresponding to the subscriber device (e.g. par. [0074]);

responsive to each certificate publication request, the messaging server temporarily storing the submitted digital certificate in a publication record in association with the submitting device as long as the associated instant messaging module remains logged-in to the messaging server (e.g. par. [0074]);

responsive to prescribed events, the messaging server providing logged-in subscriber devices with selected information concerning certificates of other subscriber devices (e.g. par. [0074]).

Schoen does not expressly disclosing receiving a particular subscriber device's request to un-publish its digital certificate; responsive to receiving the request, the messaging server removing the digital certificate from the publication record, identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use.

Perlman et al. discloses receiving a particular subscriber device's request to un-publish its digital certificate; responsive to receiving the request, the messaging server removing the digital certificate from the publication record, identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use (e.g. abstract and col. 7, lines 27-58).

It would have been obvious to a person with ordinary skill in the art to combine Perlman et al.'s receiving a particular subscriber device's request to un-publish its digital certificate; responsive to receiving the request, the messaging server removing the digital certificate from the publication record,

identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the digital certificate withdrawn from use into Schoen et al. in order to avoid overhead and inconvenience associated with the use of authentication certificates as disclosed by Perlman et al. (e.g. col. 3, lines 56-61) and since the claimed invention is merely a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of combination were predictable.

As per **claims 8 and 24**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with selected information concerning certificate status of other subscriber devices comprising: responsive to a request from one subscriber device to establish a dialog with another subscriber device, the messaging server providing the requesting subscriber device with a representation of a digital certificate of the other subscriber device from the publication record (e.g. par. [0074]).

As per **claims 9 and 25**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with selected information concerning certificate status of other subscriber devices comprising: responsive to a particular subscriber device's request to publish a new digital certificate, the messaging server identifying other logged-in subscriber devices that have designated the particular subscriber device for potential future secured instant messaging, and providing the identified devices with a representation of the new digital certificate (e.g. par. [0074]).

As per **claim 11**, Perlman et al. further discloses comprising: the particular subscriber device submitting the request to un-publish its digital certificate in response to at least one of the following events: (1) physical unavailability of the subscriber device's digital certificate, (2) logical unavailability of

the subscriber device's corresponding digital certificate, (3) user election to un-publish the subscriber device's digital certificate (e.g. col. 7, lines 27-58).

As per **claims 12 and 27**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with selected information concerning certificate status of other subscriber devices comprising: responsive to a request from a first subscriber device to establish a dialog with a second subscriber device, the messaging server denying supplication of the second subscriber's digital certificate to the first subscriber whenever the second subscriber's digital certificate has experienced one or more of the following actions: invalidity, revocation, un-publication (e.g. par. [0073]).

As per **claim 13**, Perlman et al. further discloses comprising: delaying submittal of the certificate publication request under preventive circumstances including at least one of the following: (1) physical unavailability of the digital certificate, (2) logical unavailability of the digital certificate, (3) user election to delay publication of the digital certificate (e.g. col. 7, lines 27-58).

As per **claim 14**, Perlman et al. further discloses comprising: automatically submitting the certificate publication request when the preventive circumstances terminate (e.g. col. 7, lines 27-58).

As per **claims 15 and 28**, Schoen further discloses the operation of, responsive to prescribed events, providing logged-in subscriber devices with information concerning certificate status of other subscriber devices comprising: responsive to a particular subscriber device's published certificate becoming invalid, the messaging server identifying other logged-in subscriber devices that previously designated the particular subscriber device for potential future secured instant messaging, and notifying the identified devices of the invalid digital certificate (e.g. par. [0073]).

As per **claims 16 and 29**, Schoen further discloses the operation of temporarily storing the submitted digital certificate additionally storing a representation of a chain record pertaining to the certificate, where storage of repetitive chain records are abbreviated to conserve storage space (e.g. par. [0074])

As per **claim 17**, Schoen further discloses the act of submitting the publication request is performed under one or more of the following conditions: (1) automatically in response to the act of logging in to the messaging server, (2) manually in response to operator direction (e.g. par. [0074]).

As per **claims 18 and 30**, Perlman et al. further discloses comprising operations of: at one or more of the logged-in devices, an associated local instant messaging module submitting a certificate un-publication request to the messaging server responsive to specified conditions; responsive to each un-publication request, the messaging server removing the requesting subscriber's digital certificate from the publication record (e.g. col. 7, lines 27-58).

As per **claims 19 and 31**, Schoen further discloses where: the operations further comprise, responsive to each publication request, the messaging server receiving revocation information for the subscriber's certificate; upon expiration of the certificate as indicated by the revocation information, removing the subscriber's certificate from the publication record (e.g. par. [0073]).

As per **claims 20-22,** they are rejected using the same rationale as rejecting claims 7-9, 11-19, 23-25 and 27-31 above.

Response to Arguments

11.   Applicant's arguments filed 11 December 2007 have been respectfully and fully considered but they are not persuasive.

12.   The Applicant's arguments are summarized as below:

    a.   Withdrawal 101 rejection to claims 23-31

    b.   Perlman does not teach or suggest receiving a request to un-publish a digital certificate or a process for notifying other devices that the digital certificate was withdrawn.

    c.   Dependent claims are allowable due to dependency

In response to argument 'a', the examiner respectfully disagrees. Firstly, the examiner respectfully invites the Applicant to read the examiner's first action again. Claims 23-31 are message server claims and they are not method claims. The examiner did not reject claims 23-31 under 101 because they did not produce practical and tangible results. They are rejected under 101 because there is no element positively recited as part of the server. Further, storage is being recited in claim 23 and it could be signal and carrier wave medium (page 9 of the original disclosure). Therefor, the 101 rejection is maintained for claims 23-25 and 27-31 (Please note claim 26 is canceled due to Applicant's amendment).

In response to argument 'b', the examiner respectfully traverses. It appears that the Applicant is not interpreting the previous office action as intended by the examiner. Firstly, the Applicant's remark on page 16 is different from the claim limitations being recited in the claims 7 and 23. In the claims 7 and 23, "receiving a particular subscriber device's request to un-publish its digital certificate…and notifying the identified devices of the digital certificate withdrawn from use" are being recited. They are different from Applicant's remark "receiving a request to un-publish a digital certificate or a process for notifying other devices that the digital certificate was withdrawn". Second, the Applicant is respectfully reminded that One cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. See In re Keller, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, Perlman et al. reference clearly disclosed in the abstract "A technique

for issuing and **revoking** user certificates of… According to Oxford dictionary, revoking means

withdraw. Fourth, the Applicant argues "publishing a blacklist is different from removing an entry for

the digital certificate", where is "removing an entry for the digital certificate" being recited in the

claim? Thus, it would have been obvious to one of ordinary skill in the art to incorporate Perlman et

al. with Schoen et al. since the claimed invention is merely a combination of old elements and in the

combination each element would have performed the same function as it did separately, and one of

ordinary skill in the art would have recognized that the results of combination were predictable.

In response to argument 'c', Applicant's argument for claims 7 and 23 as discussed above are

traversed and therefore, the Applicant's arguments for dependent claims are based on dependency on

claims 7 and 23 are traversed and they are not allowable.

Conclusion

13.   The Applicant is **strong urged** to review NPL programming Jabber by DJ Adams, Lord et al. (U.S.

Patent 7,131,003) and Aravamudan et al. (U.S. Patent 6,301,609) in response to the current office action.

14**.**   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in

37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the

mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this

final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed,

and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory

action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the

mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/

Examiner, Art Unit 2135

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135